

IN THE UNITED STATES PATENT DESIGNATED OFFICE (DO/US)
(National Phase of International App.: PCT/US98/21168)

In re the Application of: **James R. Broach, et al.**

International Application No.: **PCT/US98/21168**

International Filing Date: **07 October 1998**

U.S. Serial No.: **09/581,861**

Filed: **June 19, 2000**

For: **YEAST CELLS EXPRESSING MODIFIED G
PROTEINS AND METHODS OF USE THEREFOR**

Attorney Docket No.: **CPI-012C8CPUS**

Commissioner for Patents
Box PCT
Washington, D.C. 20231

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER
35 U.S.C. §371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE**

Dear Sir:

Responsive to the *Notification of Missing Requirements Under 35 U.S.C. §371* dated May 8, 2001, Applicants' attorney submits herewith for the above-identified patent application Check No. 43567 in the amount of \$780.00 for additional claim fees. Please charge any underpayments or credit any overpayments associated with this communication to our Deposit Account No. 12-0080. *For this purpose, a duplicate of this letter is enclosed.*

"Express Mail" mailing label number: EL 848 028 923 US

Date of Deposit: June 8, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Box PCT, Washington, D.C. 20231.

Signature

Larry Taylor

Please Print Name of Person Signing

Respectfully submitted,

LAHIVE & COCKFIELD, LLP



Peter C. Lauro, Esq.

Reg. No. 32,360

Attorney for Applicants

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**RESPONSE TO NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR
PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR
AMINO ACID SEQUENCE DISCLOSURES**

Dear Sir:

Responsive to the *Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures* dated May 8, 2001, Applicants' attorney submits herewith for the above-identified patent application a diskette containing a substitute Sequence Listing (with separate transmittal letter addressed to Box Sequence), and a hard (paper) copy of the substitute Sequence Listing (*pages 1-39*). Applicants hereby request that the above-referenced application be amended by replacing the hard copy of the original Sequence Listing, filed with the PCT International Search Authority on January 4, 1999, with the hard copy of the substitute Sequence Listing submitted herewith. Please charge any fees associated with this communication to our Deposit Account No. 12-0080. *For this purpose, a duplicate of this letter is enclosed.*

"Express Mail" mailing label number: EL 848 028 923 US

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Signature

Larry Taylor

Please Print Name of Person Signing

Respectfully submitted,

LAHIVE & COCKFIELD, LLP



Peter C. Lauro, Esq.

Reg. No. 32,360

Attorney for Applicants

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UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS

Box PCT

Washington, D.C. 20231

Correction

| | | |
|-------------------------------|-----------------------|------------------|
| U.S. APPLICATION NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/581861 | BROACH J | CPI-012C8US |
| INTERNATIONAL APPLICATION NO. | | |
| PCT/US98/21168 | | |
| I.A. FILING DATE | PRIORITY DATE | |
| 07 OCT 98 | 07 OCT 97 | |
| DATE MAILED: 08 MAY 2001 | | |

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as

☐ a Designated Office (37 CFR 1.494),

☒ an Elected Office (37 CFR 1.495):

☒ U.S. Basic National Fee.

☒ Copy of the international application in:

☐ a non-English language.

☒ English.

☐ Translation of the international application into English.

☐ Oath or Declaration of inventors(s) for DO/EO/US.

☐ Copy of Article 19 amendments.

☐ Translation of Article 19 amendments into English.

☒ The International Preliminary Examination Report in English and its Annexes, if any.

☐ Translation of Annexes to the International Preliminary Examination Report into English.

☒ Preliminary amendment(s) filed 16 JUN 00 and

☐ Information Disclosure Statement(s) filed and

☐ Assignment document.

☐ Power of Attorney and/or Change of Address.

☐ Substitute specification filed

☐ Verified Statement Claiming Small Entity Status.

☐ Priority Document.

☒ Copy of the International Search Report ☒ and copies of the references cited therein.

☐ Other:

2. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

☐ a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.

☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.

☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).

☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.

☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.

☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ 780.00 as a ☒ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. See attached PTO-875.

ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☒ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.

5. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed:

☐ PCT/DO/EO/917

☒ PTO-875

FORM PCT/DO/EO/905 (December 1997)

PCT/DO/EO/920

☐ Notice of Defective Translation

Sequence disk error list.

Charlita A. Burt, Paralegal

Telephone: 703-305-3734

DOCKETED
June 8, 2001 - Missing Requirements
Surcharge & Sequence Listing
May 8, 2001 - E.S.P. 15 MOK

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents,
United States Patent and Trademark
Washington, D.C.
www.uspto.gov

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|-------------------------------|--|-----------------------|------------------|
| U.S. APPLICATION NO. | | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/581861 | | BROACH | J CPI-012C8US |
| INTERNATIONAL APPLICATION NO. | | | |
| PCT/US98/21168 | | | |
| I.A. FILING DATE | | PRIORITY DATE | |
| 07 OCT 98 | | 07 OCT 97 | |

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

DATE MAILED: 08 MAY 2001

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

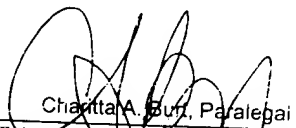
- ☐ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☐ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- ☐ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☒ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(c).
- ☐ Other: _____

APPLICANT MUST PROVIDE:

- ☐ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☒ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☒ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(c), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE
CALL:

(703) 308-4216, for Rules interpretation,
(703) 308-4212, for CRF submission help,
(703) 287-0200, for PatentIn software help.


Chantita A. Buti Paralegal
Telephone: 703-305-3734